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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,715	12/16/2003	Takahiro Ohta	018842.1283	3455

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EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,715

Applicant(s)

OHTA ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 20, 22, 23, 26-32, 34, 36, 37 and 40-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21, 24, 25, 33, 35, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/6/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election without traverse of Species III (shown in Figs. 5 & 6) in the reply filed on Dec 16, 2005 is acknowledged.
2. Claims 1-18, 20, 22, 23, 26-32, 34, 36, 37 & 40-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election of Species III (shown in Figs. 5 & 6) was made **without** traverse in the reply filed on Dec 16, 2005.
 - a. Claims 20, 34 & 41 were identified in the reply as reading on the elected species, but the claims have been withdrawn because they do not read on the elected species. The resilient member 14 in Figs. 5 & 6 is not described as having any of the limitations in these claims
 - b. Claims 26 & 40 were identified in the reply as reading on the elected species, but the claims do not read on the elected species. The first rotating member 12 in Species III does not have a first concave portion comprising an entrance portion like that recited in lines 4 & 5 of the claims.

Information Disclosure Statement

3. The listing of references in the specification as at page 1 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper."

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Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Drawings

4. The drawings are objected to because:
 - a. They fail to use the appropriate cross hatch pattern to depict the self-lubricating material member recited in claims 25 & 39.
 - b. They fail to show the lubrication layer recited in claims 24 & 38.
5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because:
 - a. The detailed description is replete with conditional terminology (see for example “transmission 1 may comprise a first rotating member” at page 7, line 12). As such, it is unclear what structure constitutes the alleged invention given that practically all the disclosed features may (or may not) be present.
 - b. Page 7, line 13 contains the nonsensical term, “a casing of a rotary equipment”.
 - c. Page 9, line 1 contains the nonsensical term, “In additional”.
7. The detailed description of the elected species is objected to as failing to provide proper antecedent basis for the following claimed subject matter:
 - a. Claim 19, lines 8 & 9: “the resilient member comprises means for damping”
 - b. Claim 19, line 8 and claim 33, line 8: “a resilient member slidably held by the entrance portion”

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 33, 35, 38 & 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 33, lines 8 & 9, recites "the resilient member comprises means to prevent the resilient member from rotating" No such "means" is taught or contemplated in the specification. To the contrary, Fig. 5 clearly shows the resilient member 14 is designed to rotate along with the members 12 & 13 when they rotate.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 24, 25, 38 & 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24, 25, 38 & 39 recite the limitation "the particular portion of the connecting member". There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 19 & 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hatakeyama, US 5,944,156. Figs. 4-6 show a power transmission comprising: a first rotating member 1 comprising at least one first concave portion 3 formed on an inner circumference of the first rotating member 1; a second rotating member 5 comprising at least one second concave portion 6 formed on an outer circumferential surface of the second rotating member, wherein the at least one second concave portion comprises an entrance portion 8 having a width which is less than an interior width of the second concave portion; and a resilient member 2 slidably held by the entrance portion. Fig. 4 shows the resilient member 2 prevents the first member 1 from rotating relative to the second member 5 when torque is less than a predetermined amount (see also col. 4, lines 28-42). Fig. 5 shows the resilient member 2 deforms and disengages from the first concave portion 3 when torque is greater than the predetermined amount (see also col. 4, lines 43-65).

14. Claims 19, 21, 33 & 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Geisthoff, US 4,802,326. Fig. 5 shows a power transmission comprising: an annular-shaped first rotating member 1 comprising at least one first concave portion 24 formed on an inner

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circumference of the first rotating member 1; a disc-shaped second rotating member 2 comprising at least one second concave portion 10 formed on an outer circumferential surface of the second rotating member, wherein the at least one second concave portion comprises an entrance portion 9 having a width which is less than an interior width of the second concave portion; and a resilient member 3 slidably held by the entrance portion. Fig. 2 shows the resilient member 3 prevents the first member 1 from rotating relative to the second member 2 when torque is less than a predetermined amount. Fig. 4 shows the resilient member 3 deforms and disengages from the first concave portion 24 when torque is greater than the predetermined amount. Fig. 5 shows the resilient member comprises an annular member and a notch 20.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 24 & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatakeyama in view of Wolff, US 2,543,396. Hatakeyama shows all the limitations of the claims but does not expressly disclose a lubrication layer between the resilient member and the first concave portion. In Fig. 4 Wolff shows a power transmission comprising a lubrication layer 38 between a resilient member 24 and a rotating member 14. In col. 4, lines 1-10, Wolff teaches providing the power transmission with the lubrication layer 38 in order to perfect separation

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between the rotating members. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the power transmission of Hatakeyama by including a lubrication layer between the resilient member and the first concave portion in order to perfect separation between the rotating members as taught by Wolff.

17. Claims 25 & 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatakeyama in view of Zeidler, US 3,183,684. Hatakeyama shows all the limitations of the claims but does not expressly disclose a self-lubricating connecting member. In col. 1, lines 59-61, Zeidler teaches providing a power transmission with self-lubricating connecting members in order to reduce friction between the rotating members. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the power transmission of Hatakeyama by including a self-lubricating connecting member in order to reduce friction between the rotating members as taught by Zeidler.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Fawick shows a power transmission comprising a resilient member 19 with a notch 19a.
- b. Focqueur shows in Fig. 9 a power transmission comprising a resilient member 27 with a notch 45.
- c. Meyer shows a power transmission.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda
Primary Examiner
Art Unit 3679